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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,550	08/05/2003	Yuuki Tauchi	241154US0	6442

22850 7590 10/19/2006

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EXAMINER
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MORILLO, JANEL COMBS

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/633,550

**Applicant(s)**

TAUCHI ET AL.

**Examiner**

Janelle Combs-Morillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36 and 39-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36 and 39-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>073106.091906</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 36, 39, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP2001-184725A (JP'725).

JP'725 teaches an optical recording medium, said medium with a reflective silver alloy layer adhered to the substrate material (see translation at [0004]). Said silver alloy contains 0.5-5% total of one or more alloying elements, wherein one of said elements can be Bi, Cu, Au, Pt (abstract), which broadly overlaps the presently claimed alloying ranges. Because the alloy composition of the instant reflective layer taught by JP'725 broadly overlaps the instant composition (36-38), it is held that JP'725 has created a prima facie case of obviousness of the presently claimed invention.

Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP § 2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility.

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3. Claims 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'725 in view of Nee'603 (US 2002/0034603A1) or Worthington (US 2005/0018583A1).

JP'725 is discussed in paragraphs above.

JP'725 does not teach the first reflective Ag-Bi layer is a semi-transmissive film with a second layer on said substrate of a reflective Ag-Bi alloy.

However, Nee'603 teaches that similar silver alloys can be used as reflective and semi-reflective layers (see [0054]), and an optical recording medium structure with a partially reflective thin film layer as a first layer directly on the substrate (see Fig. 4, [0046]), as well as a second highly reflective film/coating. Nee'603 teaches that silver alloys can be provided with moderate to high reflectivity, and have good corrosion resistance (abstract). It would have been obvious to one of ordinary skill in the art to use the silver alloy taught by JP'725 as a reflective and semi-reflective layers in a optical information recording medium structure taught by Nee'603 because Nee'603 teaches that silver alloys can be provided with moderate to high reflectivity, have good corrosion resistance, and are well suited for highly reflective and semi-reflective layers of optical disks (abstract).

Alternatively, Worthington teaches that optical disks may include a structure with a semi-reflective/partly transmissive layer of suitable silver or silver alloy, and the surface may be coated with another reflective layer. The reflectivity is selected in order to obviate readjustment of gain control when the disc reader switches it's reading between layers [0079]. It would have been obvious to one of ordinary skill in the art to use the silver alloy taught by JP'725 as a reflective and semi-reflective layers in a optical information recording medium structure taught by Worthington, because Worthington teaches an operational recording medium structure with

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said layers is beneficial to obviate readjustment of gain control when the disc reader switches it's reading between layers [0079].

4. Claims 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'725 and (Nee'603 or Worthington) in view of [Fuji et al (US 7,022,384) or JP 52-013688 (JP'688) or Nakai (US 6,689,444) or JP 2002-237097A (JP'097)].

JP'725, Nee'603, and Worthington are discussed in paragraphs above.

The prior art of JP'725, Nee'603, and Worthington do not mention the addition of a rare earth element (in particular, Nd) to said silver optical recording medium alloy. However, the prior art teaches that rare earth elements can be added to silver alloys in order to improve wear resistance/durability (JP'097 at abstract, JP'688 at abstract, Fuji at abstract, column 1 line 14, Nakai at abstract).

Fuji and Nakai also teaches that RE elements such as 0.1-3.0at% Nd suppress grain growth and decrease reflectivity losses over time (Fuji at column 3 lines 35-38, 50-51; Nakai at Fig. 15, 16).

It would have been obvious to one of ordinary skill in the art to a RE element/Nd to the Ag-Bi alloy taught by JP'725, because the prior art teaches said addition improves wear resistance/durability (JP'097 at abstract, JP'688 at abstract, Fuji at abstract, column 1 line 14, Nakai at abstract) or because Fuji and Nakai teaches that 0.1-3.0at% Nd suppresses grain growth and decreases reflectivity losses over time (Fuji at column 3 lines 35-38, 50-51; Nakai at Fig. 15, 16).

**\*\*The applied references of Fuji and Nakai have a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior**

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art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

*Copending Application No. 11/158079*

6. Claims 36, 39, 42-47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 11/158079 (US'079). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'079 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.01-3at% Bi, and 3-10at% total Nd, Sn, Gd, In (see '079 at cl. 1, 2),  $\leq 20\%$  Cu (see '079 at cl. 3).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 40-41, 48-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 11/158079 (US'079) in view of Nee'603.

It would have been obvious to one of ordinary skill in the art to use the silver alloy taught by the claims of US'079 as a reflective and semi-reflective layers in a optical information recording medium structure taught by Nee'603 because Nee'603 teaches that silver alloys can be provided with moderate to high reflectivity, have good corrosion resistance, and are well suited for highly reflective and semi-reflective layers of optical disks (abstract).

This is a provisional obviousness-type double patenting rejection.

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*Copending Application No. 11/168497*

8. Claims 36, 39-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/168497 (US'497). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'497 are also drawn to a Ag alloy reflective or semi-reflective film of an optical recording medium, said Ag alloy comprising 0.02-8at% Bi (see '497 at cl. 1, 9) 0.1-2% RE element such as Nd (see '497 at cl. 4), 0.1-3at% Cu, Au, Ph, Pd, or Pt ('497 at cl. 5).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/103615*

9. Claims 36, 39-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 11/103615 (US'615). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'615 are also drawn to a Ag alloy reflective or semi-reflective film of an optical recording medium, said Ag alloy comprising 0.05-4.5at% Bi (see cl. 1, 9), 0.1-2% Nd ('615 at cl. 5), 0.1-3% Cu, Au, Rh, Pd, Pt ('615 at cl 6).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/425062*

10. Claims 36, 39-41, 43-46, 49-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending



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Application No. 11/425062 (US'062). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'062 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.01-3at% Bi (see cl. 3), 1-10at% Nd ('062 at cl. 1, 2).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/425068*

11. Claims 36, 39-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/425068 (US'068). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'068 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.01-3at% Bi (see cl. 2), 1-10% Nd ('068 at cl. 1), 2-10at% Cu, Au, Rh, Pd, Pt ('068 at cl 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/428045*

12. Claims 36, 39-41, 43-46, 49-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 11/428045 (US'045). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'045 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.01-3at% Bi (see cl. 4), Nd ('045 at cl. 3).

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13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/375036*

14. Claims 36, 39-43, 45-49, 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/375036 (US'036). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'036 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.01-3at% Bi (see cl. 1), 0.1-3% Y ('036 at cl. 2),  $\geq 3\text{at}\%$  Cu ('036 at cl 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/395227*

15. Claims 36, 39-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 11/395227 (US'227). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'227 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.005-10at% Bi (see cl. 1), 0.1-2% Nd ('227 at cl. 6), 0.1-3at% Cu ('227 at cl 7).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Copending Application No. 11/401853*

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16. Claims 36, 39-43, 45-49, 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/401853 (US'853). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'853 are also drawn to a Ag alloy reflective film of an optical recording medium, said Ag alloy comprising 0.01-3at% Bi (see cl. 1), 0.1-3% Y ('853 at cl. 2),  $\geq 3\text{at}\%$  Cu ('853 at cl 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Amendment/Arguments***

17. In the response filed on July 31, 2006 applicant amended claims 36, 40, added new claims 42-51. The examiner agrees that no new matter has been added.

18. The examiner agrees that the submission of the translated priority documents overcomes the rejection in view of Nee'696.

19. Applicant's argument that the present invention is allowable over the prior art of record because the prior art does not teach or suggest an optical information recording medium comprising a silver alloy with the instant range of Bi has not been found persuasive. As stated in the rejections above, JP'725 teaches a broadly overlapping alloy composition. The amount of 0.5% as referred to by JP'725 relates to the minimum total amount of alloying additions, not the minimum Bi content (see abstract, translation at claim 1).

20. When the Examiner has established a *prima facie* obviousness, the burden then shifts to the applicant to rebut. *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc). Rebuttal may take the form of "a comparison of test data showing that the claimed

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compositions possess unexpectedly improved properties... that the prior art does not have, that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes, or any other argument.. that is pertinent.” Id. at 692-93; USPQ2d 1901.

Applicant has not clearly shown specific unexpected results with respect to the prior art of record or criticality of the instant claimed range (wherein said results must be fully commensurate in scope with the instantly claimed ranges, etc. see MPEP 716.02 d).

### ***Conclusion***

21. Applicant's amendment and IDS necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCM  
October 10, 2006

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